

REMARKS

Claims 1-18 were examined and reported in the Office Action. Claims 1-18 are rejected. Claims 3-7 and 10-14 are canceled. Claims 1, 8, 15 and 17 are amended. New claims 19-26 are added. Claims 1-2, 8-9, and 15-26 remain.

Applicant requests reconsideration of the application in view of the following remarks.

I. 35 U.S.C. § 102(b)

It is asserted in the Office Action that claims 15-18 are rejected under 35 U.S.C. § 102(e), as being anticipated by U. S. Patent No. 6,675,008 issued to Paik et al ("Paik"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2131,

[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.’ (Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). ‘The identical invention must be shown in as complete detail as is contained in the ... claim.’ (Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, *i.e.*, identity of terminology is not required. (In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)).

Applicant’s amended claim 15 contains the limitations of

[a] radio frequency (RF) receiver for receiving data including caller information during a voice call over a different channel from a channel for the voice call after a call connection is set up; a memory unit for storing the caller information to be linked with a telephone number of a caller terminal; and a controller for controlling a mobile terminal to display the caller information when a paging signal is received for a call with the caller terminal after terminating the voice call.

Applicant’s amended claim 17 contains the limitations of “a memory unit for storing caller information; and a radio frequency transmitter for transmitting data including caller information

during a voice call over a different channel from a channel for the voice call after a call connection is set up.”

Paik discloses the caller information is provided to a user at the terminating mobile station when a call comes in (see Paik, Abstract). Specifically, the caller information may be provided with a paging signal (see e.g., claim 16). Accordingly, it is clear that in Paik the caller information is transmitted before establishing a communication between the caller terminal and the receiver terminal. Further, Paik does not teach, disclose or suggest Applicant’s amended claim 15 limitations of “[a] radio frequency (RF) receiver for receiving data including caller information during a voice call over a different channel from a channel for the voice call after a call connection is set up,” nor Applicant’s amended claim 17 limitations of “a memory unit for storing caller information; and a radio frequency transmitter for transmitting data including caller information during a voice call over a different channel from a channel for the voice call after a call connection is set up.”

Since Paik does not disclose, teach or suggest all of Applicant’s amended claims 15 and 17 limitations, Applicant respectfully asserts that a *prima facie* rejection under 35 U.S.C. § 102(b) has not been adequately set forth relative to Paik. Thus, Applicant’s amended claims 15 and 17 are not anticipated by Paik. Additionally, the claims that directly or indirectly depend on claims 15 and 17, namely claim 16, and 18, respectively, are also not anticipated by Paik for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 102(e) rejections for claims 15-18 are respectfully requested.

II. 35 U.S.C. § 103

It is asserted in the Office Action that Claims 1-14 are rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over Statutory Invention Registration H1714 by Partridge, III (“Partridge”) in view of U.S. Patent Application No. 5,907,604 issued to Hsu (“Hsu”). Applicant’s claims 3-7 and 10-14 are cancelled. Applicant respectfully traverses the

aforementioned rejection for claims 1-2 and 8-9 for the following reasons.

According to MPEP §2142

[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Further, according to MPEP §2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” “*All words in a claim must be considered in judging the patentability of that claim against the prior art.*” (In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), emphasis added.)

Applicant's claim 1 contains the limitations of

a caller terminal for storing caller information and transmitting data including the caller information to a service system during a voice call over a different channel from a channel for the voice call after a call connection is set up; the service system for receiving the data including the caller information from the caller terminal and transmitting the data to a receiver terminal; and the receiver terminal for receiving the data from the service system, storing the caller information to be linked with a telephone number of the caller terminal, and displaying the stored caller information when a paging signal is received for a call with the caller terminal.

Applicant's claim 8 contains the limitations of

[a] method for displaying caller information, comprising: at a caller terminal, storing caller information and transmitting data including the caller information to a service system during a voice call over a different channel from a channel for the voice call after a call connection is set up; at a receiver terminal, receiving the data from the service system to store the caller information to be linked with a phone number of the caller terminal; and at the receiver terminal, displaying the stored caller information when a paging signal is

received for a call with the caller terminal.

Partridge discloses automatic still image selection and transmission upon the placement of a call to a video telephone or terminal. Partridge does not disclose, teach or suggest a method or a system by which caller information is transmitted or received during a voice call over a different channel from a channel for the voice call after a call connection is set up. That is, Partridge does not teach, disclose or suggest “a caller terminal for storing caller information and transmitting data including the caller information to a service system during a voice call over a different channel from a channel for the voice call after a call connection is set up” nor “at a caller terminal, storing caller information and transmitting data including the caller information to a service system during a voice call over a different channel from a channel for the voice call after a call connection is set up.”

Hsu discloses that the caller's Caller ID is transmitted prior to, or concurrently with, a telephone call intended to be answered by the receiving party (see Hsu, Abstract). Accordingly, it is clear that in Hsu the image is transmitted before establishing a communication between the caller terminal and the receiver terminal. Hsu does not teach, disclose or suggest “a caller terminal for storing caller information and transmitting data including the caller information to a service system during a voice call over a different channel from a channel for the voice call after a call connection is set up” nor “at a caller terminal, storing caller information and transmitting data including the caller information to a service system during a voice call over a different channel from a channel for the voice call after a call connection is set up.”

Therefore, even if Partridge is combined with Hsu, the resulting invention would still not teach, disclose or suggest “a caller terminal for storing caller information and transmitting data including the caller information to a service system during a voice call over a different channel from a channel for the voice call after a call connection is set up” nor “at a caller terminal, storing caller information and transmitting data including the caller information to a service

system during a voice call over a different channel from a channel for the voice call after a call connection is set up.”

Since neither Partridge, Hsu, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's claims 1 and 8, as listed above, Applicant's claims 1 and 8 are not obvious over Partridge in view of Hsu since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from amended claims 1 and 8, namely claims 2, and 9, respectively, would also not be obvious over Partridge in view of Hsu for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for Claims 1-14 are respectfully requested.

CONCLUSION

In view of the foregoing, it is submitted that claims 1-2, 8-9, and 15-26 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

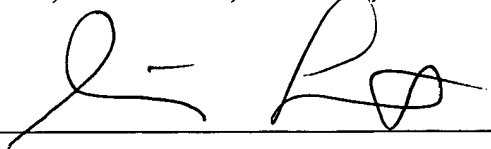
PETITION FOR EXTENSION OF TIME

Per 37 C.F.R. 1.136(a) and in connection with the Office Action mailed on March 10, 2006, Applicant respectfully petitions the Commissioner for a three (3) month extension of time, extending the period for response to September 10, 2006. Applicant submits payment in the amount of \$1,020.00 to cover the petition filing fee for a 37 C.F.R. 1.17(a)(3) large entity. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

Dated: August 31, 2006

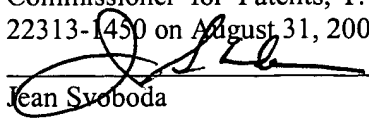
By: 

Steven Laut, Reg. No. 47,736

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025
(310) 207-3800

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on August 31, 2006.


Jean Svoboda